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PATENT
ATTORNEY DOCKET: 46884-5493

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Hiroyuki KYUSHIMA et al.) Confirmation No.: Unassigned
)
Application No.: 10/586,498) Group Art Unit: Unassigned
)
Filed: July 20, 2006) Examiner: Unassigned
)
For: PHOTOMULTIPLIER)

Commissioner for Patents
U.S. Patent and Trademark Office
Alexandria, VA 22314

Sir:

**SUBMISSION OF INTERNATIONAL PRELIMINARY
REPORT ON PATENTABILITY**

Applicants bring to the attention of the Examiner the attached document.

Attached is an English-language translation of an International Preliminary Report on Patentability ("IPRP") dated September 28, 2006 that issued in related PCT/JP2005/002302 application. Applicants respectfully request that the Examiner consider the IPRP as it relates to the above-identified application.

While the IPRP cites to US 5,568,013, US 3,244,922, JP 5-144410, JP 2000-113851 and US 3,374,380, these documents are not attached hereto because they were previously filed in an Information Disclosure Statement in this application on July 20, 2006.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the listed documents are material or constitute "prior art." If it should be determined that the listed documents do not constitute "prior art" under United States law, Applicants reserve the right to present to the office the relevant facts and law regarding the appropriate status of such document.

Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

Dated: November 14, 2006

By:



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From the INTERNATIONAL BUREAU

PCT

NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY REPORT
ON PATENTABILITY
(CHAPTER I OR CHAPTER II
OF THE PATENT COOPERATION TREATY)
(PCT Rules 44bis.3(c) and 72.2)

To:

HASEGAWA, Yoshiki
SOEI PATENT AND LAW FIRM
Ginza First Bldg.
10-6, Ginza 1-chome
Chuo-ku, Tokyo
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Date of mailing (day/month/year) 28 September 2006 (28.09.2006)	
Applicant's or agent's file reference FP04-0485-00	IMPORTANT NOTIFICATION
International application No. PCT/JP2005/002302	International filing date (day/month/year) 16 February 2005 (16.02.2005)
Applicant HAMAMATSU PHOTONICS K.K. et al	

1. Transmittal of the translation to the applicant.



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

2. Transmittal of the copy of the translation to the designated or elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SM, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference FP04-0485-00	FOR FURTHER ACTION	See item 4 below
International application No. PCT/JP2005/002302	International filing date (<i>day/month/year</i>) 16 February 2005 (16.02.2005)	Priority date (<i>day/month/year</i>) 17 February 2004 (17.02.2004)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant HAMAMATSU PHOTONICS K.K.		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Date of issuance of this report 19 September 2006 (19.09.2006)
Facsimile No. +41 22 338 82 70	Authorized officer <div style="text-align: center; font-weight: bold;">Yoshiko Kuwahara</div> e-mail: pt07@wipo.int

PATENT COOPERATION TREATY

TRANSLATION

From the
INTERNATIONAL SEARCHING AUTHORITY

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:

Date of mailing
(day/month/year)

Applicant's or agent's file reference

FP04-0485-00

FOR FURTHER ACTION

See paragraph 2 below

International application No.

PCT/JP2005/002302

International filing date (day/month/year)

16.02.2005

Priority date (day/month/year)

17.02.2004

International Patent Classification (IPC) or both national classification and IPC

Applicant

HAMAMATSU PHOTONICS K.K.

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/JP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2005/002302

Box No. 1	Basis of this opinion
1.	<p>With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.</p> <p><input type="checkbox"/> This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).</p>
2.	<p>With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:</p> <p>a. type of material</p> <p><input type="checkbox"/> a sequence listing</p> <p><input type="checkbox"/> table(s) related to the sequence listing</p> <p>b. format of material</p> <p><input type="checkbox"/> in written format</p> <p><input type="checkbox"/> in computer readable form</p> <p>c. time of filing/furnishing</p> <p><input type="checkbox"/> contained in the international application as filed.</p> <p><input type="checkbox"/> filed together with the international application in computer readable form.</p> <p><input type="checkbox"/> furnished subsequently to this Authority for the purposes of search.</p>
3.	<p><input type="checkbox"/> In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.</p>
4.	<p>Additional comments:</p>

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/JP2005/002302

Box No. V	Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement		
1. Statement			
Novelty (N)	Claims	1-3	YES
	Claims	4, 5	NO
Inventive step (IS)	Claims		YES
	Claims	1-5	NO
Industrial applicability (IA)	Claims	1-5	YES
	Claims		NO
2. Citations and explanations:			
<p>Document 1: US 5568013 A (Center for Advanced Fiberoptic Applications), 22 October 1996, Column 3, line 43 to column 4, line 8; column 6, 6th line from the bottom to column 7, line 44; Figs. 13-17</p> <p>Document 2: US 3244922 A (International Telephone and Telegraph Corporation), 05 April 1996; Fig. 7</p> <p>Document 3: JP 5-144410 A (Commissariat à l'Energie Atomique), 11 June 1993, Full text; all drawings; particularly, Fig. 14</p> <p>Document 4: JP 2000-113851 A (New Japan Radio Co., Ltd.), 21 April 2000, Full text; all drawings; particularly, Paragraph 0037</p> <p>Document 5: US 3374380 A (George W. GOODRICH), 19 March 1968; Fig. 5</p> <p><u>Claims 1-3</u></p> <p>The inventions of claims 1-3 do not appear to involve an inventive step based on documents 1-3.</p> <p>Document 1 describes a photomultiplier in which projection portion 1 is formed in one wall portion of a groove portion of an electron multiplier.</p> <p>Forming a groove portion such that projection portions are formed in the wall portions in the invention described in document 1 could be easily achieved by a person skilled in the art from the description of document 2.</p> <p>Even if the specific shape of the groove portion is changed with the object of bending the electron path in the electron multiplier, this would be a design variation that could easily be achieved by a person skilled in the art by considering the cross-section form of Fig. 14 of document 3.</p> <p><u>Claim 4</u></p> <p>The invention of claim 4 does not appear to be novel or to involve an inventive step based on document 3 or 4.</p> <p>Since a secondary electron discharge surface is formed in the surface of a projection portion in Fig. 14 of document 3, the invention of claim 4 is identical to the invention described in document 4.</p> <p>Also, paragraph 0037 of document 4 states that even electrons incident parallel to a channel necessarily collide with the electron multiplier surface and the number of electron collisions can be increased by providing at least one bending portion in the channel; projection portion 1 is formed with bending portion 1 in</p>			

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/JP2005/002302

Supplemental Box

In case the space in any of the preceding boxes is not sufficient.

Continuation of: Box V.2

Fig. 2.

Claim 5

The invention of claim 5 does not appear to be novel or to involve an inventive step based on document 3.

The projection portions described in document 3 are mutually disposed at shifted positions.

Also, the invention of claim 5 does not appear to involve an inventive step based on documents 3-5.

Forming a plurality of projection portions at shifted positions by increasing the number of bending portions based on the technical idea wherein the number of electron collisions is increased and appropriately changing the cross-section shape in the invention described in document 4 could be easily achieved by a person skilled in the art based on Fig. 5 of document 5 and Fig. 14 of document 3.